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10/752,739	01/06/2004	Manish Upendran	600189-234	4755

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EXAMINER	
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ART UNIT	PAPER NUMBER
2623	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/752,739	UPENDRAN ET AL.	
	Examiner	Art Unit	
	Paul J. Graham	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-19 and 21-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-19 and 21-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *1/7/08* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application for the following reasons:

   a. Fig. 8D, in element 840 "***NASDAQ***" is misspelled.

Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Obviousness Type Double Patenting Rejection

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In *re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b). Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/752,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim limits of a "user interface" and "client-side device" are expressly restated in the copending application No. 10/752,761 and the claim limitation of a server coupled to the data network is implied. See below.

Claim 1 of US Pat App#: 10/752,761	**Claim 1 of Instant App#: 10/752,739**
A system comprising: a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences;	*A system comprising: a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences;*
and a broadcast-based client-side device, coupled to the network, to receive broadcast programming content from a broadcast source, and to receive non-broadcast content from said data network based on said plurality of user preferences, said broadcast-based client-side device to, receive a user request to view said non-broadcast content;	and a server coupled to the data network to receive said plurality of user preferences from said user computer and to generate non-broadcast content based on said plurality of user preferences;
and display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device, wherein said non-broadcast content	*and a broadcast-based client-side device, coupled to the network, to receive broadcast programming content from a broadcast source, and to receive said non-broadcast content from said server.*

is displayed in accordance with said plurality of user preferences.	

Note the comparison above; claim 1 of the instant application is not patentably distinct from claim 1 of US Patent Application # 10/752,761.

For example, claim 1 of US Patent Application # 10/752,761, is narrower than claim 1 of instant application because it deletes the limitation "a server coupled to the data network ...". Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified claim 1 of US Patent Application # 10/752,761 to expressly recite a server coupled to the data network in order to enable the stated function of reception of content from the data network (see underlined emphasis).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. To date the terminal disclaimer for the instant application has not been approved.

Response to Arguments

Applicant argues: Houghton fails to teach or suggest the display of overlays selected by a user from a list of overlays.

3. The examiner respectfully disagrees. In view of the currently amended claim, applicant's argument is moot. The limitation added to independent claims is met by the reference Houghton et al. (US 6757707 B1) as noted below. Non-broadcast content is displayed in accordance with user preferences (Houghton, col. 8, ll. 52-59) and overlay

data (as defined in applicant's specification) is selected for display by a user from a list of overlays (Houghton, col. 5, ll. 23-26, information feeds such as a URL is selected from a list of URLs (a group of overlays themselves) as shown in fig. 10). Hence, Houghton certainly suggests and teaches the noted limitation of independent claims of 1, 11, and 21.

Therefore, based on new ground of rejection necessitated by the amended claims, independent claims 1, 11, and 21 remain rejected as do the claims dependent upon them (i.e., 2-9, 12-19, and 22-29).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 8-12, 14, 18-22, 24, 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Houghton et al. (US 6 757 707 B1).

As to claim 1, Houghton discloses a system comprising:

a user computer, coupled to a data network, to display a user interface usable to enter a plurality of user preferences (see Houghton, col. 2, ll. 15-25 for user computer; see fig. 7 for data network, see col. 6, ll. 35-42 for user interface ("featured tuning" on monitor) and figs. 8/9 for list of preferences (URL's) that are selected by user and col. 9, ll. 15-21 user may select content through preferences of TV channel or URLs selected, and col. 5, ll. 15-28 for content such as information feeds);

and a server coupled to the data network to receive said plurality of user preferences from said user computer and to generate non-broadcast content based on said plurality of user preferences (see Houghton, fig. 7 for server (host computer), see col. 8, ll. 55-61 for plural user preferences (channel lineup and other user specified preferences) preferences used by host to transmit content to user);

and a broadcast-based client-side device, coupled to the network, to receive broadcast programming content from a broadcast source, and to receive said non-broadcast content from said server (see Houghton, col. 2, ll. 15-25 for STB as client-side device and col. 9, ll. 1-9 for content (both broadcast and non broadcast) through STB based on preferences), said broadcast-based client-side device to display said non-broadcast content and said broadcast programming content on a display of said broadcast-based client-side device, and wherein said non-broadcast content is displayed in accordance with said plurality of user preferences (see Houghton, col. 7, ll. 27-44, non-broadcast content such as hot-links or URLs are displayed, user preference*s* aid the display of the complementary data (channels or URLs), col. 8, ll. 52-59), and includes overlay data to display one or more overlays on said display in conjunction with said broadcast

programming content, said one or more overlays selected by a user from a list of overlays (see Houghton, col. 5, ll. 12-17 & 23-26, information available to user is augmented with related offerings such as feeds, tickers, text chat, advertisements, or text, graphics, images, virtual worlds, sounds and movies (see Houghton, col. 2, ll. 3-6, as defined in applicant' s specification, [0076]), the overlays (see Houghton, col. 7, ll. 25-28) are shown in the PIP and background regions as well as a main image on the screen (see Houghton, fig. 8), the overlays are displayed in conjunction with the programming content (see Houghton, col. 7, ll. 50-59, a movie channel will have complementary data such as movie listings, movie-related web pages or advertisements), the overlays are chosen by a user from a list of overlays (see Houghton, col. 8, ll. 46-48, user selects a URL *feed* from a list on a content page such as shown in fig. 10, which is an overlay, the URL also triggers another overlay to appear on the content page (another complementary channel or related URL or content). The list of complementary TV channels or URLs is selected by the user (see Houghton, col. 9, ll. 23-28, user sets up the mapping which is the complementary data (including URLs, see Houghton, col. 10, ll. 50-56).

As to claim 2, Houghton discloses the system of claim 1, wherein said data network is the Internet, said broadcast source is a television programming source, and said broadcast-based client-side device includes a set top box that is coupled to the Internet and to said broadcast source (see Houghton col. 2, ll. 30-33 for network = internet, see col. 2, ll. 24-28 and fig. 7 for TV programming, see col. 7, ll. 12-20 for STB coupled to internet and broadcast source).

As to claim 4, Houghton discloses the system of claim 3, wherein said plurality of user preferences relate to one or more of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos (see Houghton, col. 7 ll. 50-58 for user preferred URLs related to movie content).

As to claim 8, Houghton discloses the system of claim 1, wherein said user interface is populated with server data from said server over said data network, said server data relating to said plurality of user preferences (see Houghton, col. 7, ll. 27-43 and fig. 8, for server data).

As to claim 9, Houghton discloses the system of claim 8, wherein said server is further to:

generate said non-broadcast content using said plurality of user preferences entered using said user interface (see Houghton, col. 6, ll. 56-65);

receive a request from said broadcast-based client-side device (see Houghton, col. 1, ll. 58-65, selection of user preferred URL web link ***is*** a request to host computer);

and transmit said non-broadcast content to said broadcast-based client-side device in response to said request (see Houghton, col. 7, ll. 37-44 and fig. 7).

As to claims 11 and 21, except for the recitation of "method" and "computer program product", respectively, they are similar to claims 1 and 9; therefore claims 11 and 21 are analyzed similar to claims 1 and 9 (see above).

As to claims 12 and 22, they are similar to claim 2; therefore, claims 12 and 22 are analyzed similar to claim 2 (see above).

As to claims 14, 18, 19, they are similar to claims 4, 8, 9, respectively; therefore, they are analyzed similar to claims 4, 8, 9, respectively.

As to claims 24, 28, 29, they are similar to claims 4, 8, 9, respectively; therefore, they are analyzed similar to claims 4, 8, 9, respectively.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 3, 7, 13, 17, 23, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houghton et al. (US 6 757 707 B1) in view of Boston et al. (US 2004/0091236 A1).

As to claim 3, Houghton discloses the system of claim 1, wherein said user interface is used to enter said plurality of user preferences; however, Houghton does not teach a user account accessed prior.

Boston, who discloses a preference entry system for video, does teach a user interface used to access a user account prior to entering said user account to be used to associate said plurality of user preferences with a particular user (see Boston, [0060] and fig. 6).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internet TV system of Houghton with the preference entry system of Boston so to make preference selection secure for multiple users of a system (see Boston, [0005-0007]).

As to claim 7, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3), wherein said user interface includes one or more drop down menus usable to enter said plurality of user preferences (see Boston for drop down menus of preference setup, fig. 6).

As to claim 13 and 23, they are similar to claim 3; therefore, they are analyzed the same as claim 3 (see above).

As to claim 17 and 27, they are similar to claim 7; therefore, they are analyzed the same as claim 7 (see above).

8. Claims 5-6, 15-16, 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houghton et al. (US 6 757 707 B1) in view of Boston et al. (US 2004/0091236 A1) in further view of Nobakht et al (US 6 813 639 B2).

As to claim 5, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3), wherein said user interface is to include a plurality of hyperlinks.

Houghton does not teach that the links are usable to access a plurality of submenus; however, Nobakht, who discloses a method for establishing internet access, does teach links that are usable to access a plurality of submenus, said submenus usable to enter said plurality of user preferences (see Nobakht, figs. 9/10 for hyperlinks (e.g., within 910B-2) to submenus to enter prefer (e.g., of 3101, choose to view business news).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the internet TV system of Houghton with the internet access method of Nobakht allows easy channel-based internet access for viewers (see Nobakht, col. 2, line 57-col. 3, line 6).

As to claim 6, Houghton discloses the system of claim 1 and Boston discloses the preference entry system (which composes claim 3) and Nobakht teaches the access to submenus of claim 5, wherein said plurality of submenus relate to one or more of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos (see Nobakht, figs. 9/10 for submenu related to entertainment (0000) or

hobby (3801) which could encompass any of games, personals, fantasy sports, movie content, music content, video on demand, content overlays, auctions and photos).

As to claims 15 and 25 they are similar to claim 5; therefore, claims 15 and 25 are analyzed similar to claim 5 (see above).

As to claims 16 and 26 they are similar to claim 6; therefore, claims 16 and 26 are analyzed similar to claim 6 (see above).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg
3/24/2008

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Primary Examiner, Art Unit 2623